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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,442	07/26/2001	Masanao Kohashi	074129-0485	4440

22428 7590 09/25/2003

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,442

Applicant(s)

KOHASHI ET AL.

Examiner

Camie S Thompson

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6 and 90 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 9, 2003 has been entered.
2. Examiner acknowledges amended claim 1.
3. Examiner acknowledges newly added claim 9.
4. The rejection of claims 1 and 4-6 under 35 U.S.C. 102(b) as being anticipated by Saito et al., U.S. Patent Number 4,491,657 is withdrawn due to applicant's argument.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al., U.S. 5,472,781.

Kim discloses a polyester multi-filamentary yarn comprising at least 90 mol percent of polyethylene terephthalate having an intrinsic viscosity of 0.85 dl/g wherein a dipped cord can be obtained as per instant claims 1, 4-6 (see abstract; column 5, lines 1-2; column 12, lines 8-11 and

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57-59). The strength and strength x (breaking elongation)^{0.5} of the polyester fiber and dipped cord comprising at least 90 mol percent of polyethylene terephthalate is greater than or equal to 6.0 cN/dtex and less than or equal to 26 cN/dtex%^{0.5} as these are physical properties of polyethylene terephthalate as per instant claims 1 and 4. Therefore, these features are inherent. In addition, the monofilament linear density, main dispersion peak temperature of loss tangent in the measurement of dynamic viscoelasticity at 110 Hz, the tenacity conversion efficiency in the dip treatment and the elongation at a specific load + dry heat shrinkage are less than or equal to 5.0 dtex, less than or equal to 147.0°C, greater than or equal to 96% and less than or equal to 7.5% respectively for the polyester multi-filamentary yarn and dipped cord comprising at least 90 mol % of polyethylene terephthalate are the physical properties of the polyethylene terephthalate as per instant claims 1 and 5-6. Therefore, these features are inherent. Tables 1 and 2 of the reference disclose the birefringence of the polyester fiber. As per claim 9, table 2 of the reference discloses a birefringence greater than 0.08. Claims 5 and 6 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. See MPEP 2113. Both Kim and applicant have a polyester dipped cord. The method in which the dipped cord is made does not make the product different. Kim and applicant both use a polyester fiber comprising 90 mol % or higher of polyethylene terephthalate having an intrinsic viscosity of 0.85dl/g or higher. The polyester dipped cord of Kim is the same as applicant's.

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Response to Arguments

7. Applicant's arguments filed August 7, 2003 have been fully considered but they are not persuasive. Applicant argues that the Kim reference discloses a birefringence value of 0.069. Applicant has amended claim 1 so that the birefringence reads greater than 0.08. Applicant argues that the polyester fiber birefringence of Kim is in contrast to the applicant's polyester fiber. In Table 2 of the Kim reference, a birefringence of 0.098 is used in comparative example 6. Therefore, it is shown that a polyester fiber comprising 90 mol% or higher having a birefringence greater than 0.08 is known. Kim discloses that the examples and comparative examples are illustrative of a polyester fiber comprising 90 mol % or higher of polyethylene terephthalate that has an intrinsic viscosity 0.85 dl/g or higher. The rejection of claims 1 and 4-6 under Kim is maintained. The Saito reference has been withdrawn due to applicant's argument.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

